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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/644,064	08/20/2003	Shingo Hane	62758-053	4353				
<div>7590 09/14/2007</div> <div>MCDERMOTT, WILL &amp; EMERY</div> <div>600 13th Street, N.W.</div> <div>Washington, DC 20005-3096</div>								
<div>EXAMINER</div> <div>GELAGAY, SHEWAYE</div>								
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/644,064

Applicant(s)

HANE ET AL.

Examiner

Shewaye Gelagay

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/7/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 7, 2007 has been entered.

#### ***Response to Arguments***

2. Applicant's arguments filed August 7, 2007 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-8 and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 8 recite, "...verifying the generated item of information for each respective one of the partial documents, and based on a result of the item verifying, determining whether each respective partial document has been deleted or modified." It is unclear what "result of the item verifying" stands for if it is for the result of verifying the generated item of information, the claim language should be corrected accordingly.

5. Claims 3-7 and 10-14 are also rejected for being dependent of the rejected claims.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claims 1 and 8 are directed to an electronic document verification system, however, the produced result remains in the abstract because the verification result has not been stored, transmitted or displayed, thus, it fails to produce tangible result and therefore lacks utility.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4-8 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (hereinafter Brown) US Patent 6,671,805 in view of Bull et al. "Content Extraction Signatures using SML Digital Signatures and Custom Transforms On-Demand", WWW2003, May 20-24, 2003, Budapest, Hungary, ACM (hereinafter Bull)

As per claims 1 and 8:

Brown teaches an electronic document management system, comprising:

a data creation device for creating an electronic document which has two or more partial documents having an arbitrary or fixed length; (col. 8, lines 35-47; col. 15, lines 17-20)

a signature device for generating a plurality of items of information, each item of information being for verifying validity of a respective one of the partial documents; (col. 8, line 57-col. 9, lines 30; col. 13, line 41-col. 14, line 63)

a masking device for masking the electronic document by deleting or modifying one or more partial documents; and (col. 12, lines 56-67; col. 13, lines 12-40)

a verification device for verifying the validity of the masked electronic document which has one or more deleted or modified partial documents, examining the validity of each of the partial documents of the masked electronic document including the one or more deleted or modified partial documents by verifying the generated item of information for each respective one of the partial documents, and based on a result of the item verifying, determining whether each respective partial document has been deleted or modified. (col. 22, line 9-col. 23, line 45)

Brown does not explicitly disclose masking after generating the items of information and the digital signature and generating an aggregate of the generated items of information for verifying the validity of the electronic document, and generating a digital signature to the aggregate of the generated items of information; and verifying the digital signature using the aggregate of the generated of information. Bull in

analogous art, however, discloses masking after generating the items of information and the digital signature and generating an aggregate of the generated items of information for verifying the validity of the electronic document, and generating a digital signature to the aggregate of the generated items of information; and verifying the digital signature using the aggregate of the generated of information. (Section 2.2 Content Extraction Signatures; 5. Practical Use of CES for Ace University) Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the system disclosed by Brown with Bull in order to enable selective disclosure of verifiable content, provide privacy for masked content. (Abstract, Bull)

As per claims 4 and 11:

The combination of Brown and Bull teaches all the subject matter as discussed above. In addition, Brown further discloses wherein the data creation device divides the electronic document by adding a delimiter to the beginning and/or end of one or more of the partial documents. (col. 8, lines 35-47; col. 15, lines 17-20)

As per claims 5 and 12:

The combination of Brown and Bull teaches all the subject matter as discussed above. In addition, Brown further discloses wherein the electronic document is a document created with a markup language, wherein the partial documents are markup units for the document created with the markup language, and wherein the delimiter is a tag for the markup language. (col. 8, lines 35-47; col. 15, lines 17-20)

As per claims 6 and 13:

The combination of Brown and Bull teaches all the subject matter as discussed above. In addition, Brown further discloses wherein each item of the information for verifying the validity of a respective one of the partial documents is a hash value which is generated with a hash function for the respective one of partial documents. (col. 22, line 9-col. 23, line 45)

As per claims 7 and 14:

The combination of Brown and Bull teaches all the subject matter as discussed above. In addition, Brown further discloses wherein each item of information for verifying the validity of a respective one of the partial documents is a digital signature for the respective of the partial documents. (col. 22, line 9-col. 23, line 45)

10. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (hereinafter Brown) US Patent 6,671,805 in view of Bull et al. "Content Extraction Signatures using SML Digital Signatures and Custom Transforms On-Demand", WWW2003, May 20-24, 2003, Budapest, Hungary, ACM (hereinafter Bull) and further in view of Lee et al. (hereinafter Lee) US Publication 2003/0145197.

As per claim 3 and 10:

The combination of Brown and Bull teaches all the subject matter as discussed above. In addition, Brown further discloses an authorization failure that notifies a signer and/or the signer's employer, bank, or the like if a signature is not successfully verified. (col. 24, line 51-col. 25, line 4) Both references do not explicitly disclose wherein the verification device displays the result of the verification on a display unit for the purpose

of notifying a verifier whether the respective partial document deleted or modified while assuring the validity of the whole electronic document. Lee in analogous art, however discloses a verification device displays the result of the verification on a display unit for the purpose of notifying a verifier whether the respective partial document deleted or modified while assuring the validity of the whole electronic document. (page 8, paragraph 53) It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the system disclosed by Brown and Bull with Lee in order to provide the verification result to the user by utilizing web documents.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shewaye Gelagay



EMMANUEL L. MOÏSE  
SUPERVISORY PATENT EXAMINER